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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/918,074

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12/23/2008

EXAMINER

HAYES, BRET C

ART UNIT

PAPER NUMBER

3641

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DELIVERY MODE

12/23/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/918,074	BEIL, JURGEN	
	Examiner	Art Unit	
	BRET HAYES	3641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 13-18 is/are rejected.
- 7) ☒ Claim(s) 8-12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 08 OCT 08 have been fully considered but they are not persuasive.
2. In response to the argument that "there is nothing in Botkins suggesting that said thermoplastic plastic is porous," examiner disagrees. While examiner alluded to the material being the same as that disclosed in Applicant's claim 7, and therefore, inherently including the claimed characteristics. Further evidence of the preference of porosity can be found at col. 2, lines 27 – 34, wherein Botkins discloses a handle **11** attached to a sleeve **14**, and the handle being fabricated of plastic, wood, metal or equivalent materials. While the disclosure of the sleeve being "attached" may be construed as the sleeve being a separate entity, from the cross-sectional view of Fig. 1, it is evident that the device can be of one-piece construction. Therefore, when Botkins states materials equivalent to wood, for example, porosity of the material can reasonably be inferred, since were one to make the device from wood, it would inherently be porous as claimed, and, were one to use 'equivalent materials,' such as equivalent to wood, for example, those materials could reasonably be construed to include the inherent porosity of wood. Further, Botkins discloses texturing, col. 2, lines 60 – 63, in order to retain viscous fluid. As such, pores – minute openings, would certainly be a viable texture.
3. Applicant's allegation that such porosity would be disadvantageous in Botkins would appear to be incorrect with respect to the citation above regarding texture of the interior of the sleeve.

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4. In response to the argument that “Bercz does not disclose the use of fish luring aromatic or enticing substances,” examiner disagrees. Bercz discloses a chemiluminescent material that anticipates the claimed “fish luring aromatic or enticing substances,” since the chemiluminescent material is an enticing substance to fish by way of illumination.

5. In response to the argument that “gas permeability does not mean that the material is porous (*emphasis in original*),” examiner disagrees. While examples of porosity have been disclosed in the specification, the term has apparently not been clearly redefined therein to avoid a broad and reasonable interpretation of the term. Because a pore is merely a minute opening or orifice, Bercz’ gas permeability is sufficient to anticipate the claimed limitation. Further, with respect to the allegation that it would be disadvantageous to use a porous thermoplastic plastic since then the light-generating chemiluminescent material would be absorbed by the gas permeable wall,” examiner disagrees. The arguments appear to be circuitous: gas permeable does not mean porous, yet the gas permeable wall would absorb the chemiluminescent material. If it can be alleged that the gas permeable wall is capable of absorbing the chemiluminescent material, it is reasonable to assert that it is porous as claimed.

6. In response to the argument that claim 6 being believed to be allowable by virtue of its dependence, for the reasons articulated, examiner disagrees. The rejection was based upon *In re Boesch*, which states that to discover an optimum value of a result effective variable involves only routine skill in the art. The dependence of a claim has little to do with its patentability.

7. The rejections, as adapted to the amended claims, stand.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 7, 13, 14, 16 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,775,023 to Botkins.

10. Re claim 1, Botkins discloses the claimed invention including a method for producing aromatic and/or enticing articles and parts thereof, comprising treating a material **14** comprising porous*, thermoplastic plastic with at least one fish-luring aromatic and/or enticing substance, as set forth at col. 3, lines 30 – 35, wherein the treated material is capable of** releasing said fish-luring aromatic and/or enticing substance. *See above for detailed explanation. If the material as claimed is clearly disclosed in the reference, then the reference inherently anticipates any known characteristics of that material as well. As to limitations which are considered to be inherent in a reference, note the case law of *In re Ludtke*, 169 USPQ 563, *In re Swinehart*, 169 USPQ 226, *In re Fitzgerald*, 205 USPQ 594, *In re Best et al.*, 195 USPQ 430, and *In re Brown*, 173 USPQ 685, 688. **It has been held that the recitation that an element is “capable of” performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138. In this case, Botkins is certainly capable of like performance as that claimed.

11. Re claim 7, as dependent upon claim 1, Botkins discloses polyolefin above.

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12. Re claim 13, Botkins further discloses adhering, welding, heat-shaping and/or printing said material before it is treated with said fish-luring aromatic and/or enticing substance. In the citation above, Botkins discloses that the material is fabricated by a molding operation, which anticipates at least ‘heat-shaping’ above.

13. Re claims 14 and 16, Botkins discloses the claimed invention as element **14** as above.

14. Re claim 17, Botkins further discloses the articles selected from the group consisting of fish-catching devices, feed baskets, buoyancy blocks for fish-catching nets, basic lead sheathings, blinker casings, spinner casings, twisters and parts thereof. In that Botkins discloses material **14** to be a sleeve, it anticipates at least ‘parts thereof’ as claimed.

15. Claims 1 – 5, 7 and 13 – 18 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 3,708,903 to Bercz et al. (*Bercz*).

16. Re claim 1, Bercz discloses the claimed invention including a method for producing aromatic and/or enticing articles and parts thereof, comprising treating a material **30, 52, 168, 170, 172**, Figs. 1 – 4 and 12, for example, comprising porous*, thermoplastic plastic, as set forth at least at col. 3, lines 14 – 24, with at least one fish-luring aromatic and/or enticing substance, the chemiluminescent material disclosed above, wherein the treated material is capable of** releasing said fish-luring aromatic and/or enticing substance. *With respect to being porous, Bercz discloses the material being gas permeable, which anticipates being porous as claimed. **See the rejection of claim 1 in view of Botkins above for explanation of being ‘capable of.’

17. Anent claims 2 – 5, Bercz discloses the claimed invention as applied above. The least diameter disclosed by Applicant for the average size of the pores is 0.1 μm . Bercz discloses the “gases [being] common to that of normal atmosphere,” at lines 10 and 11. Gases common to

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normal atmosphere include about 78% Nitrogen, 21% Oxygen and the remainder mainly Argon and Carbon Dioxide with less than 0.002% comprising other trace elements. In order to disallow even the largest of these gas molecules, presumably CO₂, for example, the pores would need to be much less than 200 picometers (pm) in diameter, since it is known that CO₂ is actually only about 163 pm across*. 163 pm is equivalent to 0.000163 µm. Clearly then, allowing gases common to normal atmosphere anticipates the limitation of the least diameter of the pores being 0.5 µm, and, therefore, also the greater diameters claimed. *With respect to this assertion, support can be found on the internet in a search for “co2” of the site for Wikipedia.

18. Re claim 7, Bercz discloses polyethylene, see above, which anticipates at least polyolefin because polyethylene is a polyolefin.

19. Re claim 13, Bercz further discloses adhering, welding, heat-shaping and/or printing said material before it is treated with said fish-luring aromatic and/or enticing substance. In the citation above, Bercz discloses that the material is stuck fast by snap-action, col. 3, lines 9 – 13, which anticipates at least ‘adhering’ above.

20. Re claims 14 – 16, Bercz discloses the claimed invention as applied above.

21. Re claim 17, Bercz further discloses the articles selected from the group consisting of fish-catching devices, feed baskets, buoyancy blocks for fish-catching nets, basic lead sheathings, blinker casings, spinner casings, twisters and parts thereof. In that Bercz discloses material **30, 52, 168, 170, 172**, Figs. 1 – 4 and 12, for example, to be a cover, it anticipates at least ‘parts thereof’ as claimed.

22. Re claim 18, Bercz discloses a method of luring fish, comprising placing a porous, thermoplastic plastic treated with at least one fish-luring aromatic and/or enticing substance in a body of water containing fish, as discussed above.

Claim Rejections - 35 USC § 103

23. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

24. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Botkins or Bercz as applied above.

25. Botkins and Bercz discloses the claimed invention including the material inherently having a void volume, except for that volume being at least 50% as claimed. It would have been obvious to one having ordinary skill in the art at the time the invention was made to manipulate the void volume to be at least 50% as claimed, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). In this case, one of ordinary skill in the art would understand that such a manipulation would help define critical characteristics of the device. Further, when there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the

fact that a combination was obvious to try might show that it was obvious under § 103. *KSR Int'l. Co. v. Teleflex Inc.*, 127 S. Ct. 1742 (2007). That being said, to manipulate the void volume to enhance desired characteristics, would be obvious to try to manipulate such.

Allowable Subject Matter

26. Claims 8 – 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

27. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Bret Hayes at telephone number (571) 272 – 6902 or email address bret.hayes@uspto.gov, which is preferred.

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The examiner can normally be reached Monday through Friday from 5:30 am to 2:00 pm, Eastern Standard Time.

The Central FAX Number is **571-273-8300**.

If attempts to contact the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone, can be reached at (571) 272 – 6873.

/Bret Hayes/

Primary Examiner, Art Unit 3641

24-Dec-08